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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,408	02/10/2000	Frederic Serre	A32979-070337.0181	3806
7590 10/21/2003			EXAMINER	
Baker & Botts 30 Rockefeller Plaza 44th Floor New York, NY 10112-4498			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 10/21/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/501,408

Applicant(s)

SERRE, FREDERIC

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-28 is/are allowed.
- 6) ☒ Claim(s) 29-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/14/03 has been entered.

2. Applicants' amendment filed 7/14/03 overcome all rejections of record.

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 29 is rejected under 35 U.S.C. 102(e) as being anticipated by Nanni et al. (U.S. 2002/0042479).

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Nanni et al. disclose tire obtained from rubber composition comprising 100 parts natural rubber and 30-150 parts silica which has surface area of 80-600 m<sup>2</sup>/g. The rubber composition is used to produce internal components of the tire (paragraphs 37, 42-45, and 68).

Attention is drawn to example 1 which discloses rubber composition comprising 100 parts natural rubber and 40 parts silica that has surface area of 165 m<sup>2</sup>/g and comprises OH groups on its surface.

In light of the above, it is clear that Nanni et al. anticipate the present claim.

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanni et al. (U.S. 2002/00042479) in view of Takeichi et al. (U.S. 6,008,295).

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The disclosure with respect to Nanni et al. in paragraph 4 above is incorporated here by reference.

The difference between Nanni et al. and the present claimed invention is the requirement in the claims of additional diene elastomer.

Takeichi et al., which is drawn to rubber compositions for tires, discloses the use of silicon or tin halide modified diene elastomer in order to produce a composition with superior fracture properties and low hysteresis loss (col.1, lines 19-22, col.2, lines 34-55, and col.6, lines 45-55).

In light of the motivation for using additional diene elastomer disclosed by Takeichi et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use this diene elastomer in the tire of Nanni et al. in order to produce tire with superior fracture properties and low hysteresis loss, and thereby arrive at the claimed invention.

7. Claims 30-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanni et al. (U.S. 2002/0042479) in view of Fukahori et al. (U.S. 5,844,050).

The disclosure with respect to Nanni et al. in paragraph 4 above is incorporated here by reference.

The difference between Nanni et al. and the present claimed invention is the requirement in the claims of additional diene elastomer that has been modified by branching agent such as divinylbenzene.

Fukahori et al., which is drawn to rubber composition, disclose a diene elastomer comprising a majority of cis-1,4-bonds, which is branched using divinylbenzene (col.9, lines 4-

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14, 32 and 46-50) in order to produce a composition with good abrasion resistance, fatigue resistance, and tensile properties (col.25, lines 26-36).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such diene elastomer in the tire of Nanni et al. in order to produce tire with good abrasion resistance, fatigue resistance, and tensile properties, and thereby arrive at the claimed invention.

**Allowable Subject Matter**

8. Claims 23-28 are allowable over the "closest" prior art JP 09302146 for the following reasons.

JP 09302146 disclose a tire which has a bead filler comprising 100 parts diene based rubber comprising predominantly natural rubber, 20-150 parts silica which has specific surface area of 210-300 m<sup>2</sup>/g, 0-50 parts carbon black which has specific surface area of 50-150 m<sup>2</sup>/g, and 5-25% based on the amount of silica, i.e. 1-37.5 parts, of silane coupling agent.

However, JP 09302146 discloses that the respective amounts of the carbon black and silica present in the bead filler tire sums to 50-150 phr, which falls outside the scope of present claim 23, which requires amount of silica and carbon black of 20 to 45 phr.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

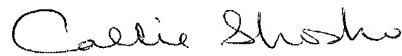
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
10/14/03